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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/658,245	09/08/2000	Lester D. Nelson	EXPL-01028US0 MCF/KJD	3031
23910	7590	10/06/2005	EXAMINER	
FLIESLER MEYER, LLP FOUR EMBARCADERO CENTER SUITE 400 SAN FRANCISCO, CA 94111			PATEL, HEMANT SHANTILAL	
			ART UNIT	PAPER NUMBER
			2645	

DATE MAILED: 10/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/658,245	NELSON ET AL.	
	Examiner	Art Unit	
	Hemant Patel	2645	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 July 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 10-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 10-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Applicant's submission filed on July 11, 2005 has been entered. The application prosecution is transferred to new examiner.

Response to Arguments

Applicant's arguments with respect to claims 1-4 and 10-15 have been considered but are not persuasive.

Regarding claims 1 and 15, the Examiner interprets conversation representation as an item selected by the user i.e. a text and a label (Instant application, Pg. 4, ll. 9-11) and a conversation element as an associated audio stored in memory (Fig. 3, 4, item 33, utterance data store, Pg. 14, ll. 17-18). Upon the selection of a particular conversation representation by the user, its associated audio utterance that is the claimed conversation element is transmitted to the other user (Pg. 14, ll. 17-20). Zahavi discloses these features in a base station storing the messages, which are selected and transmitted to the other user in response to the receipt of signals indicating the associated particular conversation representation selected by the user (Zahavi, col. 7, ll. 39-45).

The disclosed specification by Applicants refers to ***storing pre-recorded*** conversational elements in case of A) PC embodiment (Pg. 24, This is accomplished by ***storing the pre-recorded*** conversational phrases of interest in a format suitable for display and selection by the user), B) PDA embodiment (Pg. 27, indicators may be sequence numbers or addresses for digitally ***stored*** signal data, controller ***stores*** audio clips), C) Paper User Interface Embodiment (Pg. 29, A controller ***stores*** audio clips), D)

Telephone Accessory Embodiment (Pg. 30, **stores** the audio that may be accessed through the labeled control buttons), E) Telecommunications Infrastructure Embodiment (Pg. 31, The non-verbal interface is used to select and play voice utterances (**recorded** or synthetic) over the telephone connection). These are prior to the operation of cellular phone system and are not dynamically input in real-time by a user and then stored.

Furthermore, in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., conversation element that is dynamically input in real-time by a user and then stored) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

For the above reasons, applicant's arguments are not deemed persuasive and the following rejections are repeated.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 10, 12, 14, and 15 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,577,859 B1 ("Zahavi"), as cited by the applicant.

With respect to claim 1, Zahavi discloses a first electronic device (Fig. 1, calling wireless telephone 201 and col. 3, lines 24-49), a second electronic device (Fig. 2, called wireless telephone 10) coupled to a wireless telecommunications system (Fig. 1). The second electronic device (called wireless telephone 10) displays conversation representations (menu items 12) to the user of the second electronic device. A processing device (base station) (col. 7, lines 33-45) is also coupled to the telecommunication infrastructure and remote to the first device. The processing device is able to store conversation elements (standard system messages and personalized messages pre-recorded by the user) associated with the conversation representations (menu items 12) displayed on the second electronic device (called wireless telephone 10) (col. 7, lines 20-30 and 38-40). The processing device (base station) is computer-based and thus executes computer instructions (software) for providing an audible utterance (message) to the calling wireless telephone (first electronic device) in response to the user at the called wireless telephone 10 (second electronic device) selecting a displayed conversation representation (an item on menu item 12) by activating the appropriate key (col. 7, lines 28-33) (see also Fig. 3 for the general procedure). The displayed conversation representations (menu 12) are clearly text.

Claim 15 differs substantively from claim 1 in that claim 15 recites that the second electronic device stores the conversation element, provides the conversation representation, and provides the audible utterance. These differences also read on Zahavi, which also uses a processing chip internal to the second electronic device

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(cellular telephone 10) to store the conversation element, provide the conversation representation, and provides the audible utterance (col. 7, liens 20-33).

With respect to claims 10 and 14, see the claim 1 rejection for further details.

With respect to claim 12, the base station (processing device) acts as a relay between the calling wireless terminal and the called wireless terminal (see the claim 1 rejection for further details).

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 2-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zahavi as applied to claim 1 above.

Zahavi fails to specifically disclose whether in-band (e.g., DTMF) or out-of-band signaling is used however "Official Notice" is taken that both the concepts and advantage of in-band (e.g., DTMF) and out-of-band signaling would have been well known and expected in the art.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to add in-band signaling including DTMF and out-of-band signaling to the combination of base station and cellular telephone signaling disclosed in Zahavi.

The suggestion/motivation for doing so would have been to increase the compatibility of the signaling method with standard telephone networks by using in-band signaling such as DTMF as used in the user telephones disclosed by Zahavi or by increasing the efficiency and speed of call setup by using out-of-band signaling as is typically used at switching centers such as the base station disclosed by Zahavi.

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Zahavi as applied to claim 1 above, and further in view of U.S. Patent No. 6,408,177 B1 ("Parikh") as cited by the applicant.

Zahavi disclosed that the processing device (base station) is computer-based but fails to disclose that the computer is coupled to the Internet.

However, Parikh (similarly to Zahavi) teaches of a wireless, incoming call management. Further, Parikh teaches that the user replies to the incoming call by sending SMS data messages to the call management center via a data channel routed through the Internet (col. 5, lines 40-50).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to couple the base station (processing device) to a call management system via the Internet as taught by the wireless, incoming call management system of Parikh to the wireless, incoming call management system disclosed by Zahavi.

The suggestion/motivation for doing so would have been that using a data network (such as the Internet) to respond to incoming calls would have increased efficiency and reduced cost by conserving air time and network resources (Parikh, abstract).

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Zahavi as applied to claim 1 above, and further in view of U.S. Patent No. 6,389,114 B1 ("Dowens"), of record.

Zahavi fails to disclose that the device provides utterances during a conference call.

However, Dowens (similarly to Zahavi) teaches of a relay device, where the relay of Dowens also relays the messages during a conference (abstract).

Therefore, it would have been obvious to a person of ordinary skill in the art to add conferencing capability as taught by the relay device of Dowens to the relay device disclosed by Zahavi.

The suggestion/motivation for doing so would have been to increase the flexibility and efficiency of the telephone communications system by allowing multiple participants to conference together during a single call instead of requiring each party to establish

point to point calls when information is exchanged. In addition, such a modification would have conformed to telephone industry standard support for conferencing capability especially in a business environment.

Conclusion

3. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hemant Patel whose telephone number is 571-272-8620. The examiner can normally be reached on 8:00 AM - 5:00 PM.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on 571-272-7547. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Hemant Patel
Examiner
Art Unit 2645

HSP



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